

Application Serial No.: 09/986,622
Attorney Docket No.: 09877.0189-00

REMARKS

Applicants respectfully request reconsideration of the present application in view of the amendments proposed herein and the following remarks. Prior to entry of this response, claims 31-37 and 39-51 were pending in the application, of which claims 31, 34, and 51 are independent. In the Final Office Action dated November 20, 2006, claims 39-45 were objected to, claims 34-37 were rejected under 35 U.S.C. §112, first paragraph, claim 51 was rejected under 35 U.S.C. §112, second paragraph, and claims 31-37 and 39-50 were rejected under 35 U.S.C. § 103(a). Following this response, claims 31-37 and 40-51 remain pending in this application.

I. Objection to the Claims

The Examiner objected to claims 39-45 as being of improper dependent form because they depended, directly or indirectly, from canceled claim 38. Applicants propose canceling claim 39 and amending claim 40 to indicate that they depend from claim 34. Applicants respectfully submit that these amendments place claims 40-45 in condition for allowance or, alternatively, in better condition for appeal.

II. Rejection of the Claims Under 35 U.S.C. § 112, First Paragraph

In the Final Office Action, the Examiner rejected claim 51 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. Specifically, the Examiner asserted that claim 51's language "to direct a second portion of the conditioning gas to an upper portion of the muffler" is not supported by the specification, observing that Figure 4 shows the flow 152 to be above the muffler 33. In this Amendment After Final, Applicants propose amending claim 51 to recite "to direct a second portion of the conditioning gas to an upper portion of the substantially annular chamber." Support for this amendment is found in

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the specification at least at page 31, lines 7-19. Applicants believe that this proposed amendment places claim 51 in condition for allowance.

III. Rejection of the Claims Under 35 U.S.C. §112, Second Paragraph

The Examiner rejected claims 34-37 under 35 U.S.C. §112, second paragraph, contending that there is no antecedent basis for the term "distributor body" at line 9. Applicants propose amending claim 34 to reorder the elements in a manner that provides antecedent basis for the term "distributor body" in the clause referred to by the Examiner.

IV. Rejection of the Claims Under 35 U.S.C. §103

The Examiner rejected claims 31-33 and 50 under 35 U.S.C. §103(a) as being unpatentable over U.S. Publication No. 2002/0029591 ("Dickinson") (or U.S. Patent No. 5,284,499 ("Harvey")) in view of JP 08091862 ("Kazuya"), U.S. Patent No. 5,160,359 ("Strackenbrock"), and U.S. Patent No. 4,547,644 ("Bair"), and optionally in view of U.S. Patent No. 4,988,374 ("Harding"). The Examiner also rejected claims 31-33 and 50 as being obvious over Dickinson (or Harvey) in view of Kazuya, Bair, and U.S. Patent No. 4,678,490 ("Miller"), and optionally in view of Harding.

In the November 20th Office Action, the Examiner acknowledges that none of the cited references disclose a porous filter interposed between an annular distribution chamber and an outlet of a distributor body, as recited in claim 31. Instead, the Examiner argues that this feature of claim 31 would have been obvious to one of ordinary skill in the art because porous materials have been used in other arts to help evenly distribute air flow. But to present a *prima facie* case of obviousness, there must be some teaching, suggestion, or motivation to combine the teachings of the prior art to produce the claimed invention. MPEP 2143.01. This motivation must be found either explicitly or implicitly in the references themselves or in the

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knowledge generally available to one of ordinary skill in the art. *Id.* It is the duty of the Examiner to explain why the combination of references forming an obviousness rejection is proper. MPEP 2142.

Here, the Examiner has pointed to nothing in the cited references that would suggest modifying the disclosure of those references to provide a porous filter as recited in claim 31. Nor has the Examiner explained his assertion that simply because porous materials have previously been used for various purposes in other arts would motivate one of skill in the art to provide a porous filter between an annular distributor chamber and an outlet of a distributor body in a furnace for drawing an optical fiber preform as recited in claim 31. Instead, the Examiner appears to improperly rely on the hindsight of Applicants' disclosure to explain why it would have been obvious to provide a porous filter as recited in claim 31. MPEP 2142. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 31, and Applicants request that the Examiner withdraw the rejection of claim 31, as well as dependent claims 32-33 and 46-50.

With further regard to claim 48, the Examiner has pointed to nothing in the prior art teaching or suggesting an insulating material comprising a substantially cylindrical hollow body, "wherein said cylindrical body is made from a single sheet of said rigid graphite material, two opposite ends of which are curved and held in contact to each other to form the cylinder." Instead, the Examiner has simply contended that "it would be within the purview of one of ordinary skill in the art to determine additional claimed features such as size, curved shape and fiber orientation dependent on the insulation requirements and in view of teachings of EP 0 867 412 where a plurality of different shapes and insulation sizes are shown." Aug. 26, 2003 OA at 3. However, nothing in EP 0 867 412 ("the '412 reference") shows a drawing furnace

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comprising a substantially cylindrical insulating material by curving a single sheet of graphite as recited in claim 48. The mere fact that the '412 reference discloses insulation materials of different sizes and shapes provides no motivation to one of ordinary skill in the art to provide the substantially cylindrical insulating material as recited in claim 48. Accordingly, for this additional reason, a *prima facie* case of obviousness has not been established with respect to claim 48.

The Examiner also rejected claims 34-37 over the above-listed combinations. In this Amendment After Final, Applicants propose amending claim 34 to recite a "support collar adapted to horizontally slide the optical preform during operation of the drawing furnace."¹ A similar limitation was previously presented in claim 39, which Applicants now propose canceling.² The Examiner deemed in the April 6, 2006 Office Action that feature 7 of Harding "can slide, when it is not connected to any other structure." Apr. 6th OA at 7. However, Harding's feature 7 is a holding chuck that "gradually advances the preform into the furnace through the furnace entrance 8." Harding at 2:56-58. Clearly, the holding chuck 7 must be connected to something that controls its movement, else it would not "gradually advance" the preform into the furnace, but would instead free-fall into the furnace. Furthermore, nowhere

¹ Support for this limitation is found in the specification at least at page 31, line 20-page 32, line 3 and at Figure 4. Accordingly, Applicants respectfully submit that the proposed amendment adds no new matter.

² In the April 6th Office Action, the Examiner stated with respect to claim 39 that "sliding is a method step that does not (seem to) import any structure into the claims." Applicants respectfully disagree with this characterization, as claim 39 recites "support collar is free to slide atop the distributor body." Thus, claim 39 does not recite the step of sliding, but instead that the support collar have the capability to slide. However, given that Applicants propose canceling claim 39 and have rephrased this feature in proposing an amendment to claim 34, Applicants believe that this issue is moot.

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does Harding disclose that holding chuck 7 can horizontally slide, nor does it suggest modifying holding chuck 7 to provide it with this capability.

The Examiner also points to Kaiser as teaching a collar. Apr. 6th OA at 9. The Examiner does not assert, however, that Kaiser discloses a collar "adapted to horizontally slide the optical preform during operation of the drawing furnace." To the contrary, Kaiser discloses a rubber ring 27 that seals the furnace to prevent contamination. Nowhere does Kaiser disclose that the rubber ring 27 is adapted to slide horizontally during operation of the furnace. Accordingly, it does not teach or suggest this feature of amended claim 34. Furthermore, were Kaiser's rubber ring adapted to horizontally slide in the manner recited in claim 34, its intended purpose of sealing the furnace would likely be defeated.

Because Harding, Kaiser, and the remainder of cited references do not teach or suggest each feature of claim 34 as Applicants propose amending, a *prima facie* case of obviousness has not been established and Applicants request that the rejection of claims 34-37 be withdrawn.

V. Conclusion

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing the pending claims in condition for allowance or in better condition for appeal. Applicants submit that the proposed amendment and issues raised herein do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

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In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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